



TTAB

Attorney Ref.: 500162

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KAPALUA LAND Co. Ltd.

Petitioner,

v.

KAPALUA STRICKWAREN GmbH

Respondent.



01-31-2006

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Cancellation No. 92/040,092

PETITIONER'S MOTION TO AMEND CANCELLATION

Petitioner, by its attorney, hereby moves to amend the cancellation pursuant to Rule 15(a), Fed. R. Civ. Proc. Specifically, Petitioner seeks to amend the cancellation, which is currently based on (1) Abandonment; (2) Likelihood of Confusion under Section 2(d) of the Trademark Act; and (3) Dilution, to plead, as an alternative and additional ground, that Respondent committed fraud on the Patent and Trademark Office with respect to U.S. Trademark Registration No. 2,115,124 and that Registration No. 2,115,124 be cancelled on that basis.

An amended Petition to Cancel is enclosed herewith and the Board is respectfully requested to allow the amended Petition to Cancel to be substituted for the original Petition to Cancel and allow Respondent time in which to answer the amended petition.

As grounds in support of this motion, Petitioner states that during discovery, Respondent answered Petitioner's Interrogatories and Request for Production of Documents. Those answers are dated December 16, 2005. In those responses, Respondent acknowledged that it had never used the mark in Registration No. 2,115,124 in connection with all of the goods listed in that

PETITIONER'S MOTION TO AMEND CANCELLATION

Cancellation No.: 92/040,092

registration. The mark in the registration had only been used in connection with some of the goods in the registration. See attached Exhibit C to the Amended Petition to Cancel. The file history for Registration No. 2,115,124 shows that Respondent filed its Section 8 affidavit on May 19, 2004 and declared that it was using the mark in Registration No. 2,115,124 in connection with all of the goods listed in that registration. See attached Exhibit A to the Amended Petition to Cancel. By filing that Section 8 affidavit, Respondent has committed fraud on the Patent and Trademark Office.

In view of the foregoing, since Respondent's fraud on the Patent and Trademark Office has only recently come to Petitioner's attention, Petitioner seeks to amend its pleading so that the fraud on the Patent and Trademark Office issue can be determined.

Although discovery closes on January 31, 2005, Respondent will not be prejudiced by the granting of this motion. Petitioner does not need to take any further discovery regarding the issue of fraud and Respondent does not need additional discovery time to address its own acts. Respondent will be able to address the allegation of fraud on the Patent and Trademark Office responsive to motions or during its testimony period.

Since the rule provides that leave to amend a pleading shall be freely given when justice so requires, it is respectfully requested that this motion be granted and that Respondent be ordered to answer the Amended Petition to Cancel attached hereto.

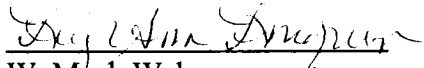
PETITIONER'S MOTION TO AMEND CANCELLATION

Cancellation No.: 92/040,092

Respectfully submitted,

KAPALUA LAND COMPANY, LTD.

By:



W. Mack Webner

Leigh Ann Lindquist

SUGHRUE, MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, DC 20037-3202

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

Attorneys for Petitioner

Date: January 31, 2005

Enclosures: Amended Petition to Cancel with Exhibits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KAPALUA LAND COMPANY, LTD.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92/040,092
)	
)	
KAPALUA STRICKENWAREN GmbH LTD.,)	FIRST AMENDED
)	PETITION TO CANCEL
)	Reg. Nos.: 2,016,976 and 2,115,124
Registrant.)	
_____)	

Petitioner, Kapalua Land Company, Ltd., a limited liability corporation of Hawaii with its principal place of business in Maui, Hawaii (hereinafter "Petitioner" or "Kapalua"), petitions to cancel Registration Numbers 2,016,976 and 2,115,124 both for the trademark KAPALUA issued to the Registrant, Kapalua Strickwaren GmbH Ltd., a corporation of the Federal Republic of Germany with a principal place of business in Hamburg, Federal Republic of Germany (hereinafter "Registrant" or "KSG"), for the reasons set forth herein below.

Facts common to all allegations:

1. Kapalua is the owner and operator of KAPALUA, the internationally renowned resort in Maui, Hawaii, which Kapalua has operated since 1975. Kapalua has used the mark KAPALUA to identify its hotel and resort since at least 1975 and has used the mark KAPALUA on clothing products, soaps, shampoos and cosmetic products since at least as early as 1975. The trademark and service mark KAPALUA has become internationally well known and is a famous mark identifying Kapalua and products and services that originate from Kapalua.

2. The word KAPALUA is a word that has no meaning in any language, though it is identified on early maps of Maui as the name of a cove or beach on the property of the KAPALUA resort.
3. On information and belief, Registrant is a corporation of the Federal Republic of Germany and has no relationship to Hawaii or Petitioner.
4. Registration No. 2,016,976 is for the word trademark KAPALUA for the goods “laundry bleach and laundry detergent, perfumes, essential oils for personal use, lipstick, rouge, eyeliner, hair lotion, and dentrifice” in International Class 003 and for “footwear, headwear, gloves” in International Class 025. Registration No. 2,115,124 is for the word trademark KAPALUA for “clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, gloves, and hats” in Class 025.

Count I. - ABANDONMENT

5. On information and belief, KSG does not use the mark KAPALUA in the United States on the goods identified in Registration No. 2,016,976, has not done so for more than three years and has no intention to use the mark on those goods in the future. On information and belief, KSG does not use the mark KAPALUA in the United States on the goods identified in registration No. 2,115,124 and has not used the mark on such goods for more than three years and has no intention to use the mark on those goods in the future.
6. The continued maintenance of Registration Nos. 2,016,976 and 2,115,124 for the mark KAPALUA by KSG for the goods identified in those registrations will

preclude the registration and will threaten the use of the mark KAPALUA by Kapalua.

Count II - LIKELIHOOD OF CONFUSION

7. The marks of Kapalua and KSG are identical. As a result of Kapalua's continued use of the trademark and service mark KAPALUA it has become internationally well known and is a famous mark identifying Kapalua and products and services that originate with Kapalua.
8. On information and belief, if KSG uses its mark in the United States, the consumer for the goods of KSG will be the same or similar consumer of Kapalua's goods and services.
9. The continued maintenance of the Registrations Nos. 2,016,976 and 2,115,124 on the Principal Register is likely to cause confusion, and is likely to deceive and mislead consumers and should, therefore, be cancelled under Section 14 of the Lanham Act.

Count III - DILUTION

10. The service mark and trademark KAPALUA is a famous mark identifying Kapalua's internationally famous resort and hotel on the island of Maui, Hawaii. Kapalua's use of the KAPALUA trademark and service mark since 1975, and its extensive advertising and promotion of the mark throughout the United States and the world has caused the mark KAPALUA to become famous and to identify only Petitioner.
11. The maintenance of the Registrations Nos. 2,016,976 and 2,115,124 on the Principal Register dilutes the fame of the mark KAPALUA of Petitioner for its

like goods and services marketed to the same or similar consumers and said dilution will cause harm to the reputation and fame of the KAPALUA mark of Petitioner.

Count IV - FRAUD on the Patent and Trademark Office, Reg. No. 2,115,124

12. Respondent has committed fraud on the Patent and Trademark Office in its filing of its Section 8 Affidavit.
13. On May 19, 2004, Respondent filed its Declaration of Continued Use for Registration No. 2,115,124. Attached as Exhibit A is that filing. In that filing, Respondent declared that it was using the mark on all of the goods listed in the registration as of May 19, 2004.
14. On October 28, 2005, Petitioner served its First Set of Interrogatories on Respondent. See attached as Exhibit B. Respondent answered those Interrogatories on December 16, 2005. Attached as Exhibit C are those responses.
15. In its Responses to Petitioner's First Set of Interrogatories, Respondent provided the following answer to Interrogatory No. 3:

Interrogatory No. 3

Identify each product on which Respondent has used Respondent's Mark.

Answer:

Pullovers, t-shirts and skirts.

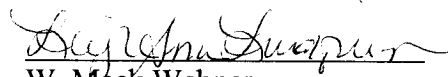
16. Respondent's verified response to Interrogatory No. 3 contradicts the information provided in Respondent's Section 8 filing.

17. Respondent filed its Section 8 declaration and fraudulently declared it was using its mark on all the goods listed in Registration No. 2,115,124, namely, clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, gloves, and hats. In its verified answers to Interrogatories served and answered in this case, Respondent indicated that it had only used the mark on pullovers, t-shirts and skirts.
18. By filing the incorrect Section 8 declaration, Respondent has committed fraud on the Patent and Trademark Office.

WHEREFORE, Petitioner respectfully requests this Honorable Trademark Trial and Appeal Board to cancel Registrations Nos. 2,016,976 and 2,115,124 from the Principal Register.

Respectfully submitted,

KAPALUA LAND COMPANY LTD.


W. Mack Webner
Leigh Ann Lindquist
Sughrue, Mion, PLLC
2100 Pennsylvania Avenue, NW
Washington, D.C. 20037
Attorneys for Petitioner

Ex A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER, DECLARATION OF USE OF A MARK UNDER SECTION 8 OF THE TRADEMARK ACT OF 1946, AS AMENDED

Name of Owner: **STYLE & SPIRIT GMBH**Registration Number: **2,115,124**Trademark: **KAPALUA**International Class(es): **25**

TO THE COMMISSIONER FOR TRADEMARKS:

Transmitted herewith is a Declaration of Use of a Mark under Section 8 and fee calculated as follows:

Total # Classes		Fee/class			
1	x	\$100.00	=	BASIC FEE	\$100.00
Check here if filing during grace			<input checked="" type="checkbox"/>	GRACE PERIOD FEE	\$100.00
				TOTAL FEE	\$200.00

- ☐ A check in the amount of _____ is attached.
- ☒ Please charge Deposit Account No. **19-4675** in the amount of **\$200.00**
- ☒ The Director is hereby authorized to charge payment of any fees associated with this Declaration of Use or credit any overpayment to Deposit Account No. **19-4675**

Certificate of Mailing by Express Mail

I certify that this document and fee is being deposited on
(Date)
with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
Signature of Person Mailing Correspondence
Typed or Printed Name of Person Mailing Correspondence
"Express Mail" Mailing Label Number

Certificate of Mailing by First Class Mail

I certify that this document and fee is being deposited on
MAY 19, 2004
(Date)
with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
Signature of Person Mailing Correspondence
MICHAEL J. STRIKER
Typed or Printed Name of Person Mailing Correspondence

Dated: **MAY 19, 2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
DECLARATION OF USE OF A MARK UNDER SECTION 8 OF THE TRADEMARK ACT OF 1946, AS AMENDED
(With Power of Attorney)

To The Commissioner for Trademarks

Docket No. **144**
Trademark: **KAPALUA**

Registration Number: **2,115,124**
Registration Date: **NOVEMBER 25, 1997**
Name of Owner: **STYLE & SPIRIT GMBH**
Address of Owner: **OBENHAUPTSTRASSE 15**
22335 HAMBURG
GERMANY

The Owner hereby appoints the below named domestic representative upon whom notice or process in the proceedings affecting the mark may be served.

Name of Domestic Rep.: **MICHAEL J. STRIKER**
Address of Domestic Representative: **103 EAST NECK ROAD**
HUNTINGTON, NY 11743

(Required ONLY if the owner's address is outside the United States)

The Owner is using the above-identified mark in commerce on or in connection with all goods listed in the above-identified registration, except for the following:

as evidenced by the attached specimen(s) showing the mark as currently used in commerce.

DECLARATION

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this document, declares that I am properly authorized to execute this document on behalf of the Owner; and all statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

Signature: _____

Name: _____

MICHAEL J. STRIKER

Title: _____

AUTHORIZED ATTORNEY

Date: _____

MAY 19, 2004

Indicate below the nature of authority under which signatory signs:

- ☐ A person with legal authority to bind the Owner; or
- ☐ A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the Owner; or
- ☒ An attorney as defined in 37 C.F.R. 10.1(c) who has an actual or implied written or verbal power of attorney from the Owner.

Contact Information:

Address all correspondence in this application to the following:

Name: _____

MICHAEL J. STRIKER

Company/Firm Name: _____

STRIKER, STRIKER & STENBY

Address Line 1: _____

103 EAST NECK ROAD

Address Line 2: _____

City: _____

HUNTINGTON

State: _____

NY

Country: _____

USA

ZIP Code/Postal Code: _____

11743

Telephone Number: _____

(631) 549 4700

Fax Number: _____

(631) 549 0404

Email Address: _____

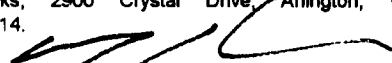
STRIKER@STRIKERLAW.COM

- ☒ Owner will accept correspondence by email.
- ☐ Owner will not accept correspondence by email.

Send to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Certificate of Mailing by First Class Mail

I certify that this document and fee is being deposited on
MAY 19, 2004 (Date)
with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
 Signature of Person Mailing Correspondence
MICHAEL J. STRIKER Typed or Printed Name of Person Mailing Correspondence

Certificate of Mailing by Express Mail

I certify that this document and fee is being deposited on
(Date)
with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
Signature of Person Mailing Correspondence
Typed or Printed Name of Person Mailing Correspondence
"Express Mail" Mailing Label Number

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION OF USE OF A MARK UNDER SECTION 8 OF THE TRADEMARK ACT OF 1946, AS AMENDED

(With Power of Attorney)

Docket No. **144**
Trademark: **KAPALUA**

Registration Number: **2,115,124**
Registration Date: **NOVEMBER 25, 1997**
Name of Owner: **STYLE & SPIRIT GMBH**
Address of Owner: **OBENHAUPTSTRASSE 15**
22335 HAMBURG
GERMANY

TO THE COMMISSIONER OF TRADEMARKS

POWER OF ATTORNEY

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Dear Sir:

I hereby appoint:

MICHAEL J. STRIKER
REG. NO.: 27233

as principal attorneys to submit this document and to transact all business in the Patent and Trademark Office connected therewith.

By: _____

MICHAEL J. STRIKER

as authorized attorney

Dated: MAY 19, 2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KAPALUA LAND Co. Ltd.

Petitioner,

v.

KAPULA STRICKENWAREN GmbH

Respondent.

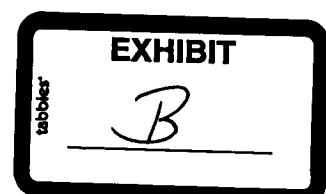
Cancellation No. 92/040,092

PETITIONER'S FIRST SET OF INTERROGATORIES TO RESPONDENT

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and Trademark Rules 2.116 and 2.120, Petitioner hereby requests that Respondent answer separately and fully, in writing and under oath, each of the following interrogatories, and serve such answers on counsel for Petitioner within thirty days of service of these interrogatories. Respondent shall supplement and/or amend its responses to the interrogatories in accordance with Rule 26(e) of the Federal Rules of Civil Procedure.

INSTRUCTIONS

1. In answering these interrogatories, please furnish all information currently known or available to you or your attorneys.
2. Please record a separate answer for each interrogatory and interrogatory subpart. Please set forth and identify the source of each answer separately by identifying each person who you know has personal knowledge of the facts or information forming the basis of the answer which you give.



3. If you contend that any information is protected by privilege, identify the privilege relied on, the persons who have the requested information and any document which contains the information, including for each document:

- a) the type of document;
- b) the author;
- c) the recipients;
- d) the date;
- e) the subject matter;
- f) the basis of the privilege.

4. If you are unable to respond fully to any interrogatory herein, you should respond to the extent possible and provide an explanation as to why a full response is not possible.

5. All interrogatories herein are directed to that information or those documents within your possession, custody or control, or within the possession, custody or control of your agents, servants and employees and, unless privileged, your attorney. They are also directed to those firms, corporations, partnerships, or trusts that you control and to documents in the possession, custody or control of the employees, agents, next friends, trustees, guardians and/or representatives of such entities.

6. These interrogatories shall be deemed to be continuing. Your attention is directed to Rule 26(e)(2) of the Federal Rules of Civil Procedure which provides as follows:

A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

DEFINITIONS

The following definitions shall apply to these interrogatories and instructions thereto:

1. "You," "Your" or "Respondent" refers to Kapalua Strickenwaren GmbH and any successors, affiliates, agents, employees, distributors and representatives.
2. "Petitioner" refers to Kapalua Land Co., Ltd. and any of its employees and representatives.
3. "Document" means that the original and all non-identical copies of any writing of any kind, which is known by you to exist or to have existed or which at any time has been in your possession, custody, or control, including, but not limited to letters, envelopes, forms, affidavits, correspondence, telegraphs, telecopies, telefaxes, paper communications, signed statements, tabulations, charts, memoranda, checks, appointment books, records, proposals, memoranda or other transcripts by mechanical device, by long hand or short hand recording, tape recorded or by electronic or by any other means, computer generated information, computer software, data stored in a computer, intra-office communications, inter-office communications, all summaries of all communications, telephonic or otherwise, microfiche, microfilm, lists, bulletins, calendars, circulars, desk pads, opinions, ledgers, minutes, agreements, journals, diaries, contracts, invoices, balance sheets, telephone messages or other messages, magazines,

pamphlets, articles, notices, newspapers, studies, worksheets, telexes, cables and all other graphic materials, writings and instruments, however produced or reproduced. A document includes all documents appended thereto.

4. “Relating to” or “Relate to” means constituting, discussing, mentioning, containing, analyzing, embodying, reflecting, identifying, incorporating, describing, commenting on, referring to, considering, recommending, dealing with or pertaining to in whole or in part.

5. “Identify” with respect to persons means to give, to the extent known, the person’s full name, present or last known address and when referring to a natural person, additionally, present or last known place of employment. Once a person has been identified in accordance with this paragraph, only the name of that person need to be listed in response to subsequent discovery requests in the identification of that person.

6. “Identify” with respect to each document means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) the author(s), addressee(s), and recipient(s).

7. “Identify” with respect to oral communications shall mean: (a) the communication medium, i.e., in person or telephonic; (b) the date of each such communication; (c) the full name and current business and residence address of those who were present at each communication; and (d) the substance and nature of each such communication.

8. “Person” means any natural person or any business, legal or governmental agency or association.

9. The connectors “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery requests all responses that might otherwise be construed to be outside its scope.

10. “Including” means including without limitation.

11. “Registration” means Registration Nos. 2,016,976 and 2,115,124.

12. “Respondent’s Mark” means the mark KAPALUA set forth in Registration Nos. 2,016,976 and 2,115,124.

13. “Commerce” is defined as set forth in 15 U.S.C. §1127.

14. Respondent’s Products shall mean those products of Respondent identified in Registration Nos. 2,016,976 and 2,115,124 that bear or are associated with Respondent’s Mark.

INTERROGATORIES

INTERROGATORY NO. 1

State the type of business in which Respondent is engaged, and identify any subsidiaries, parent companies or related companies which use Respondent’s Mark or any other name or mark in which the term KAPALUA appears.

INTERROGATORY NO. 2

Identify the person(s) most knowledgeable about the selection, adoption, use and registration of Respondent’s Mark and identify all documents which are relevant to Respondent’s selection, adoption and use of Respondent’s Mark.

INTERROGATORY NO. 3

Identify each product on which Respondent has used Respondent’s Mark.

INTERROGATORY NO. 4

With respect to each of the products identified in Registration Nos. 2,016,976 and 2,115,124, state for each such product whether Respondent has used Respondent's Mark in commerce in connection with each product and, if so, how the mark was used for each product in commerce, the date on which Respondent's Mark was first used in commerce on each product, and identify all documents evidencing and/or relating to the use of Respondent's Mark in connection with each identified product for each year from the alleged date of first use.

INTERROGATORY NO. 5

For each product identified in Registration Nos. 2,016,976 and 2,115,124 state if the use of the Respondent's Mark has been continuous.

INTERROGATORY NO. 6

For each product listed in Registration No. 2,016,976, indicate the first sale date in the United States for such product.

INTERROGATORY NO. 7

For each product listed in Registration No. 2,115,124, indicate the first sale date in the United States for such product.

INTERROGATORY NO. 8

If Respondent asserts a different date than set forth in answer to Interrogatory Nos. 5 and 6 for its first sales in "commerce", state such date for each product and describe such sales.

INTERROGATORY NO. 9

State in round numbers the dollar amount of gross sales in commerce in connection with each product rendered under Respondent's Mark for each year beginning with the date of first use.

INTERROGATORY NO. 10

Identify all documents on which Respondent relies to establish its sales of each of Respondent's Products in commerce.

INTERROGATORY NO. 11

Identify all media forms in which Respondent's Products have been advertised or promoted in connection with Respondent's Mark through the date of response to this Interrogatory.

INTERROGATORY NO. 12

State in round numbers the dollar amount Respondent has expended in connection with each medium identified in response to the preceding interrogatory for each year beginning with the date of first use of the Respondent's Mark in connection with such product up to the present.

INTERROGATORY NO. 13

Identify all documents relating to or referring to expenditures for advertising and/or promoting Respondent's Products under Respondent's Mark.

INTERROGATORY NO. 14

(a) Describe the channels of distribution through which Respondent's Products are sold under Respondent's Mark and identify the types of classes of purchasers or prospective purchasers of such products at each level of distribution.

(b) Describe the demographics of the typical consumer of Respondent's Products.

INTERROGATORY NO. 15

Identify all web sites where goods bearing Respondent's Mark have been available and/or are currently available.

INTERROGATORY NO. 16

- (a) State if Respondent has a web site.
- (b) If so, what is the domain name?
- (c) If so, how long has Respondent's website been active?
- (d) If so, can a consumer order Respondent's Products on-line or is the website only for promotional purposes?
- (e) If so, identify the dollar amount of sales of Respondent's Products through Respondent's website.
- (f) If so, identify customers in the U.S. who purchase Respondent's Products through Respondent's website.

INTERROGATORY NO. 17

Identify every trade show or meeting of any type where Respondent has displayed, advertised and/or promoted its products in association with Respondent's Marks and for each:

- (a) state the years Respondent attended each such show or meeting; and identify all documents relating to or referring to each such show or meeting identified in this interrogatory.

INTERROGATORY NO. 18

Identify representative samples of advertisements, labels, brochures, catalogs, packages or other physical indicia employed by Respondent in the use of Respondent's Mark for each of the products listed in Respondent's registrations involved herein.

INTERROGATORY NO. 19

Identify each and every U.S. retailer of Respondent's Products.

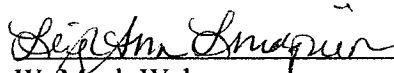
INTERROGATORY NO. 20

Identify all persons who participated in answering the foregoing interrogatories.

Respectfully submitted,

KAPALUA LAND COMPANY, LTD.

By:



W. Mack Webner

Leigh Ann Lindquist

SUGHRUE, MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, DC 20037-3202

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

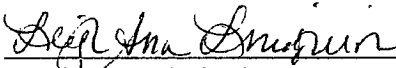
Attorneys for Petitioner

Date: October 28, 2005

CERTIFICATE OF SERVICE

I, Leigh Ann Lindquist, Esquire, hereby certify that on this 28th day of October, 2005, true and correct copies of the foregoing **PETITIONER'S FIRST SET OF INTERROGATORIES TO RESPONDENT and PETITIONER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENT'S AND THINGS** have been properly served, via First Class U.S. Mail, postage prepaid to:

Michael J. Striker
103 East Neck Road
Huntington, New York 11743
Attorney for Respondent



Leigh Ann Lindquist

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

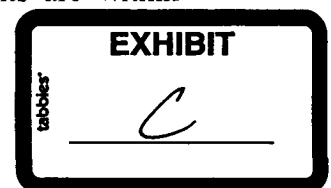
KAPALUA LAND CO., LTD.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92/040,092
)	
KAPALUA STRICKENWAREN GmbH)	
)	
Respondent.)	

**RESPONDENT'S ANSWERS TO PETITIONER'S
FIRST SET OF INTERROGATORIES TO RESPONDENT, NOS. 1-20**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Respondent, by and through its attorneys MICHAEL BEST & FRIEDRICH, LLP, 401 North Michigan Avenue, Suite 1900, Chicago, Illinois 60611, hereby answers Petitioner's First Set of Interrogatories as follows:

Each answer is subject to all objections as to competence, relevance, materiality, propriety and admissibility, and to any and all other objections on any grounds that would require the exclusion of any statements contained herein if such answers were asked of, or statements contained herein were made by, a witness present and testifying in court, all of which objections and grounds are expressly reserved and may be interposed at the time of trial. The answers given herein are without prejudice to respondent's right to supplement or to revise these answers if further investigation or discovery so indicates.

Respondent's answers shall not be deemed to constitute an admission (i) that any particular information or document(s) exists, is relevant, non-privileged, or admissible in evidence, or (ii) that any statement or characterization in Petitioner's interrogatories is accurate or complete. In addition, willingness to produce documents in answer to any particular request is in no way a concession that such documents exist, or that any such documents are within respondent's possession, custody or control.



GENERAL OBJECTIONS

A. Respondent objects to these discovery requests to the extent they purport to impose obligations beyond those imposed by the Federal Rules of Civil Procedure and by the Local Rules of this Court.

B. Respondent objects to these discovery requests to the extent that they seek information which does not appear reasonably calculated to lead to discovery of admissible evidence and, thus, are not within the scope of permissible discovery under Rule 26 of the Federal Rules of Civil Procedure.

C. Respondent objects to these discovery requests to the extent the requests seek information and documents protected by the attorney-client privilege, the attorney work-product immunity, or any other privilege or immunity.

D. Respondent objects to these discovery requests to the extent the requests seek information and documents in respondent's possession, the disclosure of which is subject to or precluded by restrictions of confidentiality imposed by, or pursuant to an agreement with, a third party.

E. Respondent will respond to these discovery requests based upon its current understanding of the facts of the case and the investigation it has conducted to date. Respondent specifically reserves the right to revise, correct, supplement or clarify any of these answers at any time during the discovery and trial preparation processes. Respondent objects to these discovery requests to the extent that they are inconsistent with these conditions.

Respondent specifically incorporates each of these General Objections into its specific answers to each of respondent's discovery requests, whether or not each such General Objection is expressly referred to in respondent's answer to a specific discovery request.

INTERROGATORY NO. 1

State the type of business in which Respondent is engaged, and identify any subsidiaries, parent companies or related companies which use Respondent's Mark or any other name or mark in which the term KAPALUA appears.

ANSWER:

Manufacture and distribution of clothing.

INTERROGATORY NO. 2

Identify the person(s) most knowledgeable about the selection, adoption, use and registration of Respondent's Mark and identify all documents which are relevant to Respondent's selection, adoption and use of Respondent's Mark.

ANSWER:

Ms. Tan. In lieu of identifying documents, respondent will make available for inspection and copying non-privileged documents responsive to this request subject to entry of a protective order.

INTERROGATORY NO. 3

Identify each product on which Respondent has used Respondent's Mark.

ANSWER:

Pullovers, t-shirts and skirts.

INTERROGATORY NO. 4

With respect to each of the products identified in Registration Nos. 2,016,976 and 2,115,124, state for each such product whether Respondent has used Respondent's Mark in commerce in connection with each product and, if so, how the mark was used for each product in commerce, the date on which Respondent's Mark was first used in commerce on each product, and identify all documents evidencing and/or relating to the use of Respondent's Mark in connection with each identified product for each year from the alleged date of first use.

ANSWER:

The mark has been used in commerce on pullovers, t-shirts and skirts. The date of first use is at least as early as 1994. Respondent objects to identifying all documents "evidencing and/or relating to the use of Respondent's Mark in connection with each identified product for each year from the alleged date of first use" on the ground that this request is overly burdensome. Without waiving this objection and in lieu of identifying documents, respondent will make available for inspection and copy representative documents after a Protective Order is agreed to and entered. Respondent will also make available for inspection and copying documents showing how the mark was used for each product.

INTERROGATORY NO. 5

For each product identified in Registration Nos. 2,016,976 and 2,115,124 state if the use of the Respondent's Mark has been continuous.

ANSWER:

No.

INTERROGATORY NO. 6

For each product listed in Registration No. 2,016,976, indicate the first sale date in the United States for such product.

ANSWER:

Unknown.

INTERROGATORY NO. 7

For each product listed in Registration No. 2,115,124, indicate the first sale date in the United States for such product.

ANSWER:

Respondent objects to this interrogatory on the ground that it is redundant of Interrogatory No. 4. Notwithstanding this objection, the first sale was at least as early as 1994.

INTERROGATORY NO. 8

If Respondent asserts a different date than set forth in response to Interrogatory Nos. 5 and 6 for its first sales in "commerce", state such date for each product and describe such sales.

ANSWER:

No response required.

INTERROGATORY NO. 9

State in round numbers the dollar amount of gross sales in commerce in connection with each product rendered under Respondent's Mark for each year beginning with the date of first use.

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 10

Identify all documents on which Respondent relies to establish its sales of each of Respondent's Products in commerce.

ANSWER:

In lieu of identifying such documents, respondent will make available for inspection and copying non-privileged documents responsive to this interrogatory upon entry of a Protective Order by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 11

Identify all media forms in which Respondent's Products have been advertised or promoted in connection with Respondent's Mark through the date of response to this Interrogatory.

ANSWER:

Respondent is checking its records and will supplement this response in due course.

INTERROGATORY NO. 12

State in round numbers the dollar amount Respondent has expended in connection with each medium identified in response to the preceding interrogatory for each year beginning with the date of first use of the Respondent's Mark in connection with such product up to the present.

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 13

Identify all documents relating to or referring to expenditures for advertising and/or promoting Respondent's Products under Respondent's Mark.

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 14

- (a) Describe the channels of distribution through which Respondent's Products are sold under Respondent's Mark and identify the types of classes of purchasers or prospective purchasers of such products at each level of distribution.
- (b) Describe the demographics of the typical consumer of Respondent's Products.

ANSWER:

- (a) This information is being gathered and respondent will supplement this answer in due course.
- (b) This information is being gathered and respondent will supplement this answer in due course.

INTERROGATORY NO. 15

Identify all web sites where goods bearing Respondent's Mark have been available and/or are currently available.

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 16

- (a) State if Respondent has a web site.

ANSWER:

Yes

- (b) If so, what is the domain name?

ANSWER:

www.kapalua.de

- (c) If so, how long has Respondent's website been active?

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

- (d) If so, can a consumer order Respondent's Products on-line or is the website only for promotional purposes

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

- (e) If so, identify the dollar amount of sales of Respondent's Products through Respondent's website,

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

- (f) If so, identify customers in the U.S. who purchase Respondent's Products through Respondent's website.

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 17

Identify every trade show or meeting of any type where Respondent has displayed, advertised and/or promoted its products in association with Respondent's Marks and for each:

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

- (a) state the years Respondent attended each such show or meeting; and identify all documents relating to or referring to each such show or meeting identified in this interrogatory.

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 18

Identify representative samples of advertisements, labels, brochures, catalogs, packages or other physical indicia employed by Respondent in the use of Respondent's Mark for each of the products listed in Respondent's registrations involved herein.

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 19

Identify each and every U.S. retailer of Respondent's Products.

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 20

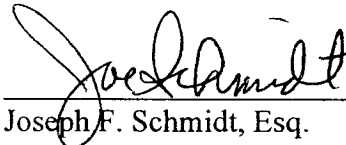
Identify all persons who participated in answering the foregoing interrogatories.

ANSWER:

Respondent will supplement its answer when it supplements the preceding interrogatory.

December 16, 2005

By:



Joseph F. Schmidt, Esq.

Gretchen M. Hosty, Esq.

MICHAEL BEST & FRIEDRICH LLP

401 North Michigan Avenue, Suite 1900

Chicago, IL 60611

(312) 661-2100

(312) 222-0818 (fax)

Attorneys for Respondent

VERIFICATION

I, _____, declare as follows:

1. I am the _____ of
_____, the Respondent in this proceeding.

2. Respondent's Answers to Petitioner's First Set of Interrogatories to Respondent, Nos. 1-20 were prepared by counsel in consultation with me.

3. The facts stated in the Answers are based in part on the business records of _____ and in part upon my personal knowledge.

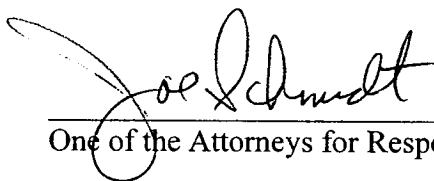
4. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **RESPONDENT'S ANSWERS TO PETITIONER'S FIRST SET OF INTERROGATORIES TO RESPONDENT, NOS. 1-20** was served by first class mail, postage pre-paid, on this 16th day of December upon:

W. Mack Webner
Leigh Ann Lindquist
SUGHRUE, MIRON, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202

via first class mail, postage prepaid, this 16th day of December 2005.

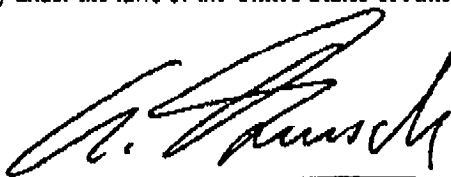


One of the Attorneys for Respondent

VERIFICATION

I, Nicolaus Reusch, declare as follows:

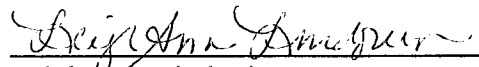
1. I am the Managing Director of STYLE & SPIRIT GmbH, the Respondent in this proceeding.
2. Respondent's Answers to Petitioner's First Set of Interrogatories to Respondent, Nos. 1-20 were prepared by counsel in consultation with me.
3. The facts stated in the Answers are based in part on the business records of STYLE & SPIRIT GmbH and in part upon my personal knowledge.
4. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

22.12.05 

CERTIFICATE OF SERVICE

I, Leigh Ann Lindquist, hereby certify that on January 31, 2006, a true copy of **PETITIONER'S MOTION TO AMEND CANCELLATION** with enclosures was sent via First Class U.S. Mail, postage prepaid to:

Joseph F. Schmidt
Michael Best & Friedrich, LLP
401 N. Michigan Avenue, Suite 1900
Chicago, IL 60611



Leigh Ann Lindquist